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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,379	12/18/2000	Janine L. Helms	10004480-1	8819

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EXAMINER
QURESHI, SHABANA

ART UNIT	PAPER NUMBER
2155	2

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	09/745,379	HELMS, JANINE L.
	Examiner	Art Unit
	Shabana Qureshi	2155

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _18 December 2000_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-20_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-7 and 9-20_ is/are rejected.

7)☒ Claim(s) _8_ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _18 December 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 19 is objected to because of the following informalities: Dependency is improper.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing

to particularly point out and distinctly claim the subject matter which applicant regards as the

invention. The matter of claim 5, "…identifying an action for the peripheral devices to take

upon occurrence of a condition" is vague and indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon Leong

et al (US Patent No. 5,996,010).

As per claim 11, Leong et al teach a method comprising:

- communicating, by a peripheral device in a intranet, a request to a predetermined

  web site hosted by a server that is not in the intranet (column 6, lines 23-34); and

- in response to the communicating, receiving a predetermined device configuration

from the predetermined web site (column 3, lines 52-57);

Leong et al does not specify that in response to receiving the configuration commands

sent by the remote server, the predetermined device configures itself. However, in column 13,

lines 42-57, Leong et al teach the presentation of management commands in an HTML document

to the peripheral device. It would have been obvious to one of ordinary skill in the art at the time

the invention was made that the peripheral device implements the management commands

received from the remote server in order to allow itself to be managed remotely (column 1, lines

54-58).

As per claim 12, Leong et al teach a method as recited in claim 11. Leong et al further

teach that the predetermined web site is a printer management service (column 6, lines 13-22,

network management agent), the response is a printer configuration (column 5, lines 46-61,

network management information), and the peripheral device is a printer (column 6, lines 19-

21, end device may be a peripheral).

As per claim 13, Leong et al teach a method as recited in claim 11, wherein the peripheral

device comprises an embedded web server for generating Web pages (column 2, lines 54-65),

the communicating further comprising encoding the configuration request as a Web page

(column 2, lines 54-65).

As per claim 14, Leong et al teach a method as recited in claim 11. Leong et al teach

that the device configuration is encoded as a web page and wrapped in HTTP (column 9, lines

16-17) such that a peripheral device that includes an embedded web server can parse and execute

the encoded device configuration to configure one or more settings or resources that correspond

to the peripheral device (column 9, lines 10-43). Leong et al does not specify that the web pages contain XML. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to store the information on the web page in XML because it is commonly known that XML is scalable to many applications.

As per claim 15, Leong et al teach a method as recited in claim 11, further comprising:

- in response to a condition, forwarding, a notification message to the predetermined web site (column 3, lines 36-52);

-receiving a notification response based on the notification message from the predetermined web site, the response comprising a set of control functions (column 3, lines 36-52); and

-in response to receiving the notification response, implementing one or more of the set of control functions (column 3, lines 36-52).

As per claim 16, Leong et al teach a computer-readable medium storing computer-executable instructions that, when executed on a computer, performs the method of claim 11 (column 4, lines 19-23).

Claims 1-4, 6, 10, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon Leong et al (US Patent No. 5,996,010) in view of Charles Keyes et al (US Patent No. 6,516,427).

As per claim 1, Leong et al teach a method providing peripheral device management the method comprising:

- pre-configuring a peripheral device to communicate a request to a predetermined

    web site (column 3, lines 62-65) upon booting up in the intranet (column 4, lines 19-

    23; column 3, lines 35-50);

- receiving the request at the predetermined web site from the preconfigured

    peripheral device (column 3, lines 52-57)

in response to receiving the request:

- generating a response based on the request, the response comprising one or more

    control commands used by the preconfigured peripheral device to perform one or

    more functions (column 3, lines 48-61); and

- communicating the response to the preconfigured peripheral device (column 6, lines

    31-32).

Leong does not teach that the predetermined web site is on a separate server from the

peripheral device. However, Keyes et al teach request-response exchange between a peripheral

and a web server on a separate network protected by a firewall (column 4, lines 29-41). It would

have been obvious to one of ordinary skill in the art at the time the invention was made to

modify the teachings of Leong et al to place the network management web site on a server

separate from the peripheral device and protected by a firewallso that the peripheral device

within a protected intranet may be serviced without personnel since "personnel are generally in

short supply and are often not able to respond to such a problem (Keyes et al, column 1, lines 35-

38)".

As per claim 2, Leong et al in view of Keyes et al teach a method as recited in claim 1.

Leong et al further teach that the predetermined web site is a printer management service

(column 6, lines 13-22, network management agent), the response is a printer configuration

(column 5, lines 46-61, network management information), and the peripheral device is a

printer (column 6, lines 19-21, end device may be a peripheral).

As per claim 3, Leong et al in view of Keyes et al teach a method as recited in claim 1,

wherein the request is a configuration request, the method further comprising:

- determining a default device configuration corresponding to the peripheral device

    (column 5, lines 46-61, network management information is default device

    configuration); and

- wherein the response further comprises the default device configuration (column 3,

    lines 40-56; column 5, lines 46-61, network management information is default

    device configuration).

As per claim 4, Leong et al in view of Keyes et al teach a method as recited in claim 3.

Leong et al further teach the determining further comprises presenting a user interface to a

customer for the customer to select one or more configuration settings corresponding to the

peripheral device (column 3, line 65 – column 4, line 5).

As per claim 6, Leong et al in view of Keyes et al teach a method as recited in claim 3.

Leong et al teach that the device configuration is encoded as a web page and wrapped in HTTP

(column 9, lines 16-17) such that a peripheral device that includes an embedded web server can

parse and execute the encoded device configuration to configure one or more settings or

resources that correspond to the peripheral device (column 9, lines 10-43). Leong does not

specify that the web pages contain XML. However, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to store the information on the web

page in XML because it is commonly known that XML is scalable to many applications.

As per claim 10, Leong et al in view of Keyes et al teach a computer-readable medium

storing computer-executable instructions that, when executed on a computer, performs the

method of claim 1 (column 4, lines 19-23).

As per claim 17, Leong et al teach a system comprising:

-a web site being configured to determine a default device configuration corresponding

to a peripheral device (column 3, lines 35-50; column 6, lines 29-31, management

information is obtained according to the request), the peripheral device being

preconfigured to communicate a request to the web site upon being booted up in an

intranet, the web site not being hosted by a server that is part of the intranet (column

3, lines 62-65; column 4, lines 19-23, column 6, 23-31),

-in response to receiving the request, the web site is configured to communicate the

default device configuration to the peripheral device (column 3, lines 48-61), the

default device configuration being communicated (column 6, lines 31-32), the

default device configuration being used by the peripheral device to configure itself

(column 13, lines 38-46).

Leong does not teach that the predetermined web site is on a separate server from the

peripheral device protected by a firewall. However, Keyes et al teach request-response exchange

between a peripheral and a web server on a separate network protected by a firewall (column 4,

lines 29-41). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to modify the teachings of Leong et al to place the network management

web site on a server separate from the peripheral device so that the peripheral device may be

serviced without personnel since "personnel are generally in short supply and are often not able

to respond to such a problem (Keyes et al, column 1, lines 35-38)".

As per claim 18, Leong et al in view of Keyes et al teach the system as recited in claim

17, wherein the peripheral device comprises an embedded web server to communicate the

request as a web page (column 2, lines 54-65) and to parse the communicated default device

configuration (column 9, lines 10-43), the communicated default device configuration being

communicated as a web page (column 2, lines 54-65).

Claims 5, 7, 9, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Leon Leong et al (US Patent No. 5,996,010) in view of Charles Keyes et al (US Patent No.

6,516,427), further in view of Michael Sorens et al (US Patent No. 6,6317,848).

As per claim 5, Leong et al in view of Keyes et al teach a method as recited in claim 3.

Neither Leong et al nor Keyes et al clearly teach that the determining further comprises

identifying an action for the peripheral devices to take upon occurrence of a condition.

However, Sorens et al teach that peripheral devices have predetermined trigger events (column

1, lines 49-58). It would have been obvious to one of ordinary skill in the art at the time the

invention was made to implement the trigger events feature of Sorens et al into the combination

of Leong et al and Keyes et al because doing so would allow the HTTP server of Leong et al to

be notified of events and apply the appropriate network management function (Leong et al,

column 1, lines 54-60).

As per claim 7, Leong et al in view of Keyes et al teach the method as recited in claim 1. Leong et al nor Keyes et al teach providing requests by sending emails. However, Sorens et al teach:

- providing an e-mail address, the request being a notification message that is communicated to the e-mail address (column 1, lines 49-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the e-mail notification feature of Soren et al into the combination of Leong et al and Keyes et al because doing so would allow the HTTP server of Leong et al to be notified of events and apply the appropriate network management function (Leong et al, column 1, lines 54-60).

As per claim 9, Leong et al in view of Keyes et al teach a method as recited in claim 1. Leong further teaches the method comprising:

- determining a response based on the request, the response specifying a set of control functions that address the request (column 3, lines 36-52); and

- forwarding the response to the peripheral device such that the peripheral device can implement the set of control functions (column 3, lines 36-52).

Leong et al nor Keyes et al teach providing requests by sending emails. However, Sorens et al teach:

- providing an e-mail address, the request being a notification message that is communicated to the e-mail address (column 1, lines 49-58).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the e-mail notification feature of Sorens et al into the combination of

Leong et al and Keyes et al because doing so would allow the HTTP server of Leong et al to be

notified of events and apply the appropriate network management function (Leong et al, column

1, lines 54-60).

As per claim 19, Leong et al teach a system as recited in claim 18. Leong et al nor Keyes

et al teach providing requests by sending emails. However, Sorens et al teach:

- providing an e-mail address, the request being a notification message that is

    communicated to the e-mail address (column 1, lines 49-58).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to implement the e-mail notification feature of Sorens et al into the combination of

Leong et al and Keyes et al because doing so would allow the HTTP server of Leong et al to be

notified of events and apply the appropriate network management function (Leong et al, column

1, lines 54-60).

As per claim 20, Leong et al in view of Keyes et al, further in view of Sorens et al teach

the system as recited in claim 19, Leong et al further teach that the response comprises one or

more control codes corresponding to functions to be performed by the peripheral device upon

receipt of the response (column 6, lines 31-32).

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leon Leong et al

(US Patent No. 5,996,010) in view of Keyes et al, further in view of Michael Sorens et al (US

Patent No. 6,6317,848), further in view of Masahito Ohtani (US Patent No. 6,108,099).

Leong et al in view of Keyes et al further in view of Sorens et al teach the method as

recited in claim 7. Neither Leong et al nor Keyes et al nor Sorens et al teach that the response is

selected from a group of responses comprising of ordering a toner cartridge for the printer or

dispatching a service representative to service the printer on-site. However, Ohtani teaches

selection from a group of responses comprising of ordering a toner cartridge for the printer or

employing a service representative to service the printer on-site (column 7, lines 30-47). It

would have been obvious to combine the feature of ordering toner service into the teachings of

Leong et al in combination with Keyes et al and Sorens at al because doing so would replenish

the toner supply since it can't be replenished through configuration management commands or

through email (column 1, 50-56).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Shabana Qureshi whose telephone number is (703) 308-6118.

The examiner can normally be reached on Monday - Friday, 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain T. Alam can be reached on (703) 308-6662. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Shabana Qureshi
Examiner
Art Unit 2155

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19 April 2004

HOSAIN ALAM
SUPERVISORY PATENT EXAMINER